

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 18

Attorney's Docket No.: 100110018-1

REMARKS

Drawings: The Examiner requested formal drawings be submitted as the original drawings as filed were informal. Further, the Examiner objected to the drawings per 37 CFR 1.84(p)(5) as FIG. 2 included a reference character 200 that was not mentioned in the description.

Applicant has provided formal drawings in the instant response and modified the specification to include a reference character 200 on page 9, line 21. No new matter has been added as the amendment merely makes the specification conform to the drawings as filed. Accordingly, the Applicant respectfully requests the Examiner accept and enter the replacement drawings and withdraw the objection to FIG. 1.

Specification: The Examiner objected to the disclosure as it included an informality, namely, "Data may be delineated be keywords" at page 12, paragraph 3, line 12. Applicant revised this sentence to read "Data may be delineated by keywords" to address this typographical informality and believes the objection should be removed.

In addition, Applicant has revised numerous paragraphs from page 9 through 12 to include reference numerals to make the specification more closely conform to the figures. This

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 19

Attorney's Docket No.: 100110018-1

was done to more precisely describe that which that Applicant believes his invention. No new matter has been added and the Applicant respectfully requests the Examiner enter these proposed amendments.

Claims: The Examiner rejected Claims 25 and 26 under 35 U.S.C § 101 as because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner has argued in the instant office action, “ ‘An electronic system, comprising: means for...’ is non-statutory since it is not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement. This is true even if the claimed operations include hardware, since it is the intent of the execution of the system and not the system itself that include such hardware.”

Applicant respectfully submits that claim 25 and claim 26 are proper subject matter as they fall under 35 U.S.C § 112 paragraph 6, providing: “an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in supports thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” Accordingly, the Applicant has merely defined a structure for performing a particular function through the use of a means expression and specified structures corresponding to the means

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 20

Attorney's Docket No.: 100110018-1

disclosed in the patent specification. Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 28 (1997).

Even if claim 25 and claim 26 were not considered 'means plus function' claims they remain proper subject matter under 35 U.S.C § 101. In *State Street Bank & Trust Co., v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1998), the Federal Circuit articulated the following test for patentability under this section developed from *In re Alappat*, 33 F.3d 1526; 31 U.S.P.Q.2d (BNA) 1545 (Fed. Cir. 1994), and *Arrhythmia Research Technology, Inc., v. Corazonix Corp.*, 958 F.2d 1053; 22 U.S.P.Q.2d (BNA) 1033 (Fed. Cir. 1992). A claim defines subject matter eligible for patent protection if the claim contains a practical application or, equivalently, if the invention defined by the claim produces "a useful, concrete and tangible result."

1. A result is useful if it lies within the technological arts.

Although the court in *State Street* did not further define the term "useful," courts have previously interpreted "useful" as meaning "in the technological arts. See *Evans v. Eaton*, 16 U.S. 454; 4 L. Ed. 433; 3 Wheat. 454 (1818) (explaining that "a patent may be for a new and useful art; but it must be practical"); *In re Toma*, 575 F.2d 872 (C.C.P.A. 1978) (holding that a "method for enabling a computer to translate natural languages is in the technological arts, *i.e.*, it is a method of operating a machine")

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 21

Attorney's Docket No.: 100110018-1

In the instant case, claim 25 and claim 26 are directed toward a system for processing electronic mail and configuring an electronic system. For example, claim 25 recites, "means for configuring the electronic system with the user-selected preference data" and claim 26 recites, "means for transmitting the user-preference data retrieved from the database to the electronic system". The language and context of this claim clearly indicate that the Applicant is claiming statutory subject matter as it relates to electronic email and configuring electronic devices and is clearly within the technological arts and useful.

**2. A result is concrete or tangible, and thus not abstract, if it
lies within the physical realm.**

The terms "tangible" and "concrete" come from the *Alappat* case. In that case, the Federal Circuit explained that "abstract ideas" were "disembodied," or divorced from physical manifestations. Patentable subject matter, on the other hand, was tangible and concrete.

Given the foregoing, the proper inquiry in dealing with the so called mathematical subject matter exception to § 101 alleged herein is to see whether the claimed subject matter as a whole is a disembodied mathematical concept, whether categorized as a mathematical formula, mathematical equation, mathematical algorithm, or the like, which in essence represents nothing more than a "law of nature," "natural phenomenon," or "abstract idea."

Claims to a specific machine that lies in the physical realm, however, are not abstract, as the Federal Circuit explained:

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 22

Attorney's Docket No.: 100110018-1

Although many, or arguably even all, of the means elements recited in claim represent circuitry elements that perform mathematical calculations, which is essentially true of all digital electrical circuits, the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. n23 This is not a disembodied mathematical concept which may be characterized as an "abstract idea," but rather a specific machine to produce a useful, concrete, and tangible result.

As previously described, claim 25 and 26 recites a specific electronic system for operating on electronic mail in a variety of ways and programming an electronic system with user-selected preference data. Like the case in *Allapat*, the Applicant in the instant case has provided 'means for' limitations to perform these various processes with a particular physical manifestation. Clearly, claim 25 and 26 are not abstract concepts as it is not only uses electronic mail and electronic devices in the physical realm but is grounded in a physical manifestations as it solves the physical problem of configuring electronic devices.

Applicant respectfully submits that the Examiner's rejection of claims 25-26 under 35 U.S.C § 101 appears not to have a specified basis in statute or case law. Nonetheless, even if there were some basis for this rejection there appears ample support in other case law and

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 23

Attorney's Docket No.: 100110018-1

statutes to withdraw this rejection. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 25-26 under 35 U.S.C § 101.

Claims 1-3, 5-7, 10-14, 18-20, 25, and 26 were rejected under 35 U.S.C § 102(e) as being anticipated by Fleming et al., (US Pat. 6,625,444).

However, the Examiner has failed to establish the prima facie case as each and every element of independent claims 1-3, 5-7, 10-14, 18-20, 25, and 26 are not taught by Fleming. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2D (BNA) 1913, 1920 (Fed. Cir.), cert. denied, 493 U.S. 853, 107 L. Ed. 2d 112, 110 S. Ct. 154 (1989) (explaining that an invention is anticipated if every element of the claimed invention, including all claim limitations, is shown in a single prior art reference). See *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985) (explaining that the identical invention must be shown in as complete detail as is contained in the patent claim). See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D (BNA) 1051, 1053 (Fed. Cir. 1987) (explaining that a prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim). See *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. (BNA) 81, 84 (Fed. Cir. 1986) ("Absence from the reference of any claimed element negates anticipation.")

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 24

Attorney's Docket No.: 100110018-1

Fleming describes storing a phone number in a phone found through a directory assistance system (DAS) (Col. 4, lines 24-30 of Fleming). More specifically, Fleming's requirements include "verbally providing entity information to the DAS" (See FIG. 4, FIG. 5, FIG. 6 and corresponding text Col. 4, lines 9-11; Col. 4, lines 53-55; Col. 4, lines 64-65; Col. 5, lines 10-12). In other words, Fleming requires a person to make a phone call to the DAS (i.e., dial 411 or the equivalent) and then verbally request a phone number and address. Clearly, this cannot qualify Fleming as teaching or even suggesting claim 1 without hindsight reconstruction of the invention. See *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention") *Grain Processing Corp. v American Maize-Products Corp.*, 840 F. 2d 902, 5 USPQ2d 1788 (Fed. Cir 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'")

Unfortunately, the Applicant respectfully points out that Fleming does not generate "an electronic mail message in response to data entered by a user, the electronic mail message including user-selected preference data for the electronic system" as recited in claim 1. Instead, Fleming requires a phone call to be made and a verbal request for a phone number. Making a

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 25

Attorney's Docket No.: 100110018-1

verbal request is not data entry by a user. Moreover, Fleming looks this information up in a database of the DAS and sends the results to a phone. Fleming is inflexible as the data is limited to information that is already located in the DAS and does not include data entered by the user.

Further, Fleming does not "automatically extract the user-selected preference data from the electronic mail message" as recited in claim 1 but instead is limited to parsing out a telephone number and alphanumeric identifier (Col. 5, lines 4-6 of Fleming). For example, Fleming can not be used to program preferences of a handheld device as it only describes a phone number and handheld devices have many different preferences to be programmed.

Indeed, Fleming does not teach or suggest, "configuring the electronic system with the user-selected preference data" as recited in claim 1. For example, Fleming is limited to merely storing a phone number and possibly an address in a phone as that is all a DAS is capable of providing (Summary of the Invention/Col. 2, lines 1-22, Claim 1 and Col. 3, lines 13-33 of Fleming). Consequently, for at least this additional reason Fleming does not anticipate claim 1.

Accordingly, claim 1 is in condition for allowance in view of Fleming. While dependant claims 2-9 are allowable on their own, they are also in condition for allowance based upon their dependency of claim 1 as well.

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 26

Attorney's Docket No.: 100110018-1

Independent claims 10, 18, 25 and 26 are also in allowance for at least the same reasons as claim 1 described above. Corresponding dependant claims 11-17, 19-24 are allowable on their own but also in condition for allowance by virtue of their dependency on their parent claims.

Examiner further rejected claims 1, 2, 6, 10-12, 18, 19, 25 and 26 under 35 USC 102(e) in view of L'Heureux et al. (US Pat. No. 6,697,942 – hereinafter the '942 patent).

Unfortunately, the Examiner has failed to establish the prima facie case as each and every element of independent claims 1, 2, 6, 10-12, 18, 19, 25 and 26 are not taught by the '942 patent. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2D (BNA) 1913, 1920 (Fed. Cir.), cert. denied, 493 U.S. 853, 107 L. Ed. 2d 112, 110 S. Ct. 154 (1989) (explaining that an invention is anticipated if every element of the claimed invention, including all claim limitations, is shown in a single prior art reference). See *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985) (explaining that the identical invention must be shown in as complete detail as is contained in the patent claim). See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D (BNA) 1051, 1053 (Fed. Cir. 1987) (explaining that a prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim). See *Kloster Speedsteel*

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 27

Attorney's Docket No.: 100110018-1

AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 U.S.P.Q. (BNA) 81, 84 (Fed. Cir. 1986)

("Absence from the reference of any claimed element negates anticipation.")

The '942 patent describes a data formatting method for sending various data types in electronic mail messages to a user (Abstract, Col. 4, lines 33-36). Unfortunately, the '942 patent explicitly does not do each and every limitation of claim 1 and therefore cannot anticipate claim 1. In particular, the '942 patent does not operate by "automatically extracting the user-selected preference data from the electronic mail message;" and "transmitting the user-selected preference data to the electronic system" as recited in claim 1.

Instead, the '942 patent transmits the electronic mail directly to the desktop email terminal (DET) without first extracting the user-selected preference data (Col. 8, lines 1-10). This requires the DET in the '942 patent to have a full electronic mail message processing capability to process the electronic mail; which in fact it does (Fig. 3/parser 312, decryption 322; Col. 8, lines 1-10). For example, a parser module 312 separates the message into command or data blocks and the identifier module 314 determines what type of diverse data is contained in the blocks.

It is important to recognize the electronic device as recited in claim 1 directly receives user-selected preference data while the DET in the '942 patent does not. Based on the '942

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 28

Attorney's Docket No.: 100110018-1

patent the electronic device is required to have the ability to process a electronic mail while the electronic device recited in claim 1 has no such requirement. Consequently, the electronic devices recited in claim 1 would not work with the '942 patent.

Accordingly, claim 1 is in condition for allowance in view of the '942 patent. While dependant claims 2-9 are allowable on their own, they are also in condition for allowance based upon their dependency of claim 1 as well.

Independent claims 10, 18, 25 and 26 are also in allowance for at least the same reasons as claim 1 described above. Corresponding dependant claims 11-17, 19-24 are allowable on their own but also in condition for allowance by virtue of their dependency on their parent claims.

Examiner also rejected claims, 4, 8, 9, 15-17, and 21-24 under 35 USC 103(a) over Fleming and further in view of Brown (US Pat. No. 6,625,444).

First, Applicant respectfully submits that claims 4, 8, 9, 15-17, and 21-24 are patentable as they depend from claims that are patentably distinct over the cited art. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, ___, 5 USPQ2d 1596 (Fed. Cir. 1988).

Nonetheless, the Examiner has provided no express, implied or inherent motivation or suggestion to combine Fleming with Brown. Examiner has made no attempt to provide any

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 29

Attorney's Docket No.: 100110018-1

credible suggestion or motivation to combine the teaching of directory assistance in Fleming with transcoding electronic mails in different formats from Brown. ("To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

In this case, the Examiner contends that Brown is "In a related art of e-mail communication" thus justifying combining Brown with Fleming. Unfortunately, the test is *not* whether two different items cited by the Examiner are "related art" but whether there is a suggestion or motivation to combine. Clearly, the Examiner has failed to properly combine these references as required. Because the Examiner has made no attempt to provide a proper justification for combining these references then the corresponding rejection under 35 USC

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 30

Attorney's Docket No.: 100110018-1

103(a) should be removed. For this additional reason, claims, 4, 8, 9, 15-17, and 21-24 remain allowable subject matter.

Claims 1-26 are now in condition for allowance. Claims 1-26 are neither taught nor suggested by Fleming, Brown or L'Heureux alone or combination.

Applicant : Shackleford et al.
Patent No. : n/a
Issued : n/a
Serial No. : 10/078,618
Filed : 09/17/2001
Page : 31

Attorney's Docket No.: 100110018-1

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Leland Wiesner, Applicants' Attorney at (650) 853-1113 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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